

REMARKS

An Office Action was mailed on October 29, 2003. Claims 1-17 are pending.

Applicant is again submitting herewith a Change of Correspondence form. All future correspondence in this matter should be directed to Customer Number 026304. The attorney docket number has also changed to 3182/FBR (031035-87566), and it is respectfully requested that the Examiner update such information in the PALM system.

In this response, claim 1 has been amended, claim 5 has been deleted and claim 18 has been added. Consequently, claims 1-4, 6-18 are under consideration. Support for the amendments to claim 1 can be found, for example, at page 5, lines 13-21 of the specification and in the drawings. Support for new claim 18 can be found at, for example, page 4, line 33 through page 5, line 12 and page 5, line 34 through page 7, line 4 of the specification and in the drawings. Therefore, no new matter has been added. Amendment of a claim is not to be construed as a dedication to the public of any subject matter.

Claims 1-4 and 15-17 stand rejected under 35 USC §103(a) as being unpatentable over US Patent No. 6,142,873 to Weiss et al. (referred to below as "Weiss") in view of US Patent No. 4,743,024 to Helm et al. (referred to below as "Helm").

Claims 5-7, 9-12 and 14 further stand rejected under 35 USC §103(a) as being unpatentable over Weiss and Helm as applied to claim 4 in view of US Patent No. 5,743,800 to Huard et al. In this regard and, more specifically with respect to claim 5, the office action asserts that:

Weiss and Helm teach the invention substantially as claimed. Weiss discloses a threshold value such that when that threshold value is reached by the graphical display without having been stopped by the player, a losing outcome results (Figure 2, column 1, lines 62- column 2, line 17 of Weiss). Weiss does not, however, specifically state that the game controller selects the threshold value. Huard teaches the game controller randomly selecting the bonus amount (abstract). The bonus amount is equivalent to the threshold - it represents the maximum bonus amount available. Randomly determining the bonus amount (threshold) increases the excitement of the game.

The amendment to claim 1 is, effectively the inclusion of claim 5 into claim 1. With respect, the Examiner is quintessentially relying on the benefit of hindsight to reject the claims under Weiss in view of Helm and Huard. Regarding the cited passage of Weiss, column 1, line 62- column 2, line 17, does not disclose a threshold value which, when reached, without having been stopped by the player *during the changing of the representation* results in a losing outcome as required by claim 1 of the present invention as taught.

The Examiner asserts that, with respect to claim 1, Helm teaches a slot machine with a skill stop feature that gives the player control of over what indicia are displayed when the player operates a control device. Based on this, the Examiner concludes that this means that the prize is dependent on when during the changing of the representation the player operates the control device.

As previously explained to the Examiner and as explicitly stated in Helm at column 2, lines 52-55, the "skill spin" feature to which the Examiner refers (column 5, 30-42) associated with each drum is used by the player to stop each reel (or drum) in an attempt to stop that reel in a position "displaying a required number". The "skill stop" feature of Helm has nothing to do and does not teach the stopping of a *changing representation* and the position at which that representation is stopped being indicative of a prize (if any) awarded to the player. The "skill stop" feature of Helm is thus not used directly to determine the prize awarded nor, in fact, to determine a prize amount at all. The "skill stop" feature relates only to the use of a measure of skill by the player in an attempt to obtain a required number. If the required number is obtained, a fixed, known predetermined prize is awarded. Helm therefore in no way teaches, hints or suggests a variable prize with a change in representation being indicative of that variable prize. In other words, Helm does not teach the stopping of a *changing representation* where the player has no idea what the amount of the prize might be. Helm therefore cannot "provide the benefit of heightening player enjoyment as is taught by the present invention".

Huard relates to casino table games. There is no teaching at all in Huard of a feature which has a *change in representation of the awarding of a prize and a player operable control device which, upon manipulation by a player, controls an outcome of the feature to determine an amount awarded to the player*. The Examiner asserts that Huard teaches a game controller

randomly selecting a bonus amount and then states that the bonus amount is equivalent to the threshold. There is no basis for making this determination in the teachings of Huard. There is no need for a "threshold" in the teachings of Huard. What is taught in the abstract of Huard is a random selection of a winning card or combinations of cards or random selection of a person or group of persons eligible to win upon possession of the card or combination of cards. The amount which is awarded as a prize is randomly selected. There is therefore no hint, teaching or suggestion in Huard *of the prize, if any, awarded to the player [being] dependent on when, during the changing of the representation, the player operates the control device with a losing outcome resulting if the player operates the control device after the threshold value has been reached.*

As indicated above, it is respectfully submitted that the Examiner is relying on the benefit of hindsight analysis in order to reject the claims. The Examiner has not indicated why one of ordinary skill in the art would, for example, rely on the teachings of Huard, which relates to casino table games and not slot machines, in order to arrive at a slot machine game having increased player enjoyment.

The Examiner asserts that it is generally known to those of ordinary skill in the art that skill stop games give the player a feeling of control plus they are more challenging than simple slot machines. As indicated above, all that Helm teaches, is a skill stop game which provides a fixed, predetermined prize. There is no hint, teaching or suggestion in any of the citations of a changing representation which needs to be controlled by a player in order to win a prize and that, if the player does not stop the changing representation in a timely fashion, a losing outcome could result. The Examiner has clearly not demonstrated why one of ordinary skill in the art would combine the teachings of Weiss, Helm and Huard in order to arrive at the present invention as claimed.

As previously argued, the CAFC stresses that, for a § 103 rejection to stand, the Examiner is required to show **with evidence** the motivation, suggestion or teaching of the desirability of making the specific combination at issue. That evidence is required to counter the powerful attraction of a hindsight-based obviousness analysis. See, for example, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002) ("Our case law makes clear that the

best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). It is respectfully submitted that this involves more than a mere bald assertion that it would be obvious to combine the cited references. With respect, the Examiner has failed to indicate why one of ordinary skill in the art would be motivated to combine the teachings of Weiss, Helm and Huard, particularly bearing in mind that Weiss relates to a game where the player has as long as the player wants to make a decision, that Helm does not teach a changing representation and that Huard relates to a table game and not a slot machine game. *In re Lee* requires that the record must state with particularity all the evidence and rationale on which the PTO relies for a rejection and sets out that it is necessary to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

Under *Lee*, the PTO must state in writing **the evidence** on which it bases its rejection. With respect, the present office action falls far short of this requirement.

From the above, it is manifestly clear that the Examiner is taking pieces of the claims and attempting to fit the references to those pieces.

It is well established that a claim must be read as a whole. Also, in a combined reference obviousness rejection, the citations relied upon are required to disclose all of the elements of the claimed invention. This, quite clearly, is not the case in this application.

Insofar as claim 18 is concerned, there is no teaching, hint or suggestion in the citations relied upon, whether singly or in combination of *a feature having a prize awarding phase during which a changing animation sequence, representative of the awarding of the prize, nor that the game control means [selects] a threshold value which, at least initially, is hidden from a player.* Further, none of the citations teaches that *the prize, if any, awarded to the player being dependent on when, during the animation sequence, the player operates the control device and a losing outcome resulting if the player operates the control device after the threshold value has been reached, the animation sequence displaying the losing outcome.*

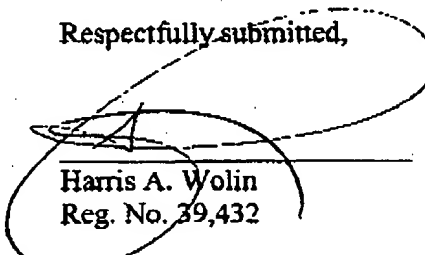
In the circumstances, the invention as claimed in claim 18 is novel and inventive over the prior art of record.

In the circumstances, it is respectfully submitted that claim 1, in its present form is patentably distinguishable over the prior art and withdrawal of the rejection of the claims under 35 USC §103(a) is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-4 and 6-18, consisting of independent claims 1 and 18 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



Harris A. Wolin
Reg. No. 39,432

CUSTOMER NUMBER 026304
PHONE: (212) 940-8708
FAX: (212) 894-5708 (direct)
DOCKET NO.: 3182/FBR (031035-87566)